

REMARKS

In the Office Action mailed May 16, 2007, the Office requires a further election of a single invention for prosecution on the merits. The Office Action has identified the following inventions under 35 U.S.C. 121:

I. Claims 74, (and 75?), and 77-78, drawn to an integrated circuit device comprising a film derived from certain methods, classified in class 428, subclass 689.

II. Claims 76 and 77, drawn to a method of making a metal powder, classified in class 427, subclass 446.

Applicant confirms the provisional election of the invention of group II made by telephone on May 2, 2007. The election is made without traverse. In view of this applicant understands that claims 74, 75, and 78-88 are withdrawn from further consideration, as being drawn to a non-elected invention.

Claim Analysis

In considering both issued patent 6,777,565 and the currently pending claims, the Office Action has indicated an issue with regard to whether compounds in claim 2 of the '565 patent lack an antecedent basis in claim 1. In view of the Certificate of Correction which was filed to correct errors in claims 2, 8, 10, and 13, applicant believes the respective compounds recited in claim 2 of the '565 patent do in fact have an antecedent basis. With regard to the claims currently pending, claim 76 is an independent claim and although claim 77 depends on claim 76, the added elements relate to method elements rather than structural elements.

With regard to claim 76, the step recited secondly, involves dispersing a vapor or liquid into the medium provided, the vapor or liquid containing an organometallic compound of the formula $(R^1)_mM(PR^2_3)_x$. Neither claim 76 nor claim 77 require the organometallic compound to be a phosphite. As noted on page 3 of the specification, such organometallic compounds can include a metal organometallic phosphite or phosphine compound. Applicant respectfully believes that claim 76, as currently provided, correctly represents the compounds intended to be claimed. If applicant has misunderstood the issue presented here, further clarification is requested.

Claim Rejections – 35 USC §112

Claim 76 was rejected under 35 U.S.C. §112, second paragraph for omitting essential steps. MPEP § 2172.01 was cited to support the current rejection. The first paragraph of the cited MPEP section relates to rejections under § 112 for omitting matter disclosed to be essential to the invention as described in the specification or in other statements of record.” The second paragraph of MPEP § 2172.01 relates to rejections for failing “to interrelate essential elements of the invention as defined by applicant’s specification.”

If the rejection was in fact meant to be under the first paragraph of § 112, applicant respectfully traverses the rejection because the Office Action cited no matter specified as essential in the specification or subsequent prosecution records that was missing from claim 76. If the rejection was intended to be under the second paragraph of § 112, applicant respectfully traverses the rejection because the Office Action cited no essential elements which were not interrelated.

To overcome the rejection, the Office Action encouraged applicant to provide more detail in the claim language directed to “how the product is realized.” Such a requirement would require applicant to provide the mechanism for the transformation achieved rather than the manipulative process steps involved.

Applicant appreciates the favorable comments regarding the allowability of claims 76 and 77, provided the issues of 35 U.S.C. § 112 are dealt with. In view of the comments above, favorable consideration of the application and allowance of claims 76 and 77 is requested.

Respectfully submitted,

By Edward E. Sowers
Edward E. Sowers, Esq.,
Reg. No. 36,015
Woodard, Emhardt, Moriarty, McNett & Henry LLP
111 Monument Circle, Suite 3700
Indianapolis, IN 46204-5137
(317) 634-3456 Telephone
(317) 637-7561 Facsimile

Attorney for Applicant